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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,710	02/10/2004	Maneesh Agrawala	MS307302.01/MSFTP592US	3842
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AMIN, TUROCY & CALVIN, LLP			EXAMINER	
127 Public Square			WANG, JIN CHENG	
57th Floor, Key Tower				
CLEVELAND, OH 44114			ART UNIT	PAPER NUMBER
			2628	
			NOTIFICATION DATE	DELIVERY MODE
			12/11/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

doctet1@thepatentattorneys.com  
hholmes@thepatentattorneys.com  
lpasterchek@thepatentattorneys.com

# Office Action Summary

**Application No.**

10/775,710

**Applicant(s)**

AGRAWALA ET AL.

**Examiner**

JIN-CHENG WANG

**Art Unit**

2628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

Applicant's submission filed on 11/14/2008 has been entered. Claims 1 and 20 have been amended. Claims 1-20 are pending in the application.

***Claim Objections***

Claim 1 is objected to because of the following informalities: "a microprocessor" should be "a pen-based microprocessor device", in accordance with the line 10-11 of Page 18 in Applicant's specification, at line 8 of claim 1, "a digital document" should "an underlying digital document". Also, to further clarify the claimed subject matter, "an input device for activating the inking region within the annotation window" should be inserted before "an annotation management component" at line 7 of claim 1. Appropriate correction is required.

Claim 14 is objected to because of the following informalities: at line 7 of claim 14, "at least one digital document" should be "at least one underlying digital document". Also, please insert "activating the inking region within the zoom window via an input device" before "generating" at line 3 of claim 14. Also "manually and automatically re-positioning and re-sizing the zoom window and the inking region" at lines 6-7 of claim 14, should be substituted with "manually and automatically re-positioning and re-sizing, by a pen-based computer system, the zoom window and the inking region". Appropriate correction is required.

Claim 20 is objected to because of the following informalities: "a microprocessor" should be "a pen-based microprocessor device", in accordance with the line 10-11 of Page 18 in Applicant's specification. At lines 5-6 of claim 20, "an electronic document" should "an

underlying electronic document”. The claim 20 recites a single hardware mean “microprocessor”. Also, further clarify the claimed subject matter, “means for activating the inking region within the annotation window” should be inserted before “means for generating” at line 5 of claim 20. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

#### **Claims 14-19:**

Claim 14 is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled “Clarification of ‘Processes’ under 35 U.S.C. 101”). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. The claims failed to identify the apparatus that accomplishes the method steps. For example, the claim 14 failed to identify the apparatus that

accomplishes the steps of “generating...”, “scaling”, “re-positioning and re-sizing...”, “positioning...”, “navigating...” and “terminating...”, set forth in the method claim 14. The steps which include instruction are merely descriptive material without reaching a final result as being useful, concrete and tangible.

Since claim 14 includes a 101 judicial exception, claim 14 must be for a practical application of the judicial exception. As is, claim 14 failed to recite either a physical transformation or produce a useful and tangible result. Thus, claim 14 is also non-statutory for this reason.

Applicant merely claims steps of “generating...”, “scaling”, “re-positioning and re-sizing...”, “positioning...”, “navigating...” and “terminating...” Said steps are merely descriptive material without reaching a final result as being useful, concert and tangible.

As per 35 USC 101 guidelines nonfunctional descriptive material may be claimed in combination with other functional descriptive multi- media material on a computer readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 USC 101.

Claims 15-19 are non-statutory for the same reasons discussed above.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim invention is not clearly construed. The Examiner suggests the following amendment to the claim 1 to further clarify the subject matter which applicant regards as the invention. In a non-limiting example, "a microprocessor" should be "a pen-based microprocessor device". At line 8 of claim 1, "a digital document" should "an underlying digital document". Also, "an input device for activating the inking region within the annotation window" should be inserted before "an annotation management component" at line 7 of claim 1. Clarification is required. The claims 2-13 and 20 are subject to the same rationale of rejection set forth in the claim 1.

***Allowable Subject Matter***

Claims 14-19 would be allowable if rewritten or amended to overcome the rejection(s) under 101 and/or 112 rejections, set forth in this Office action.

The following is an examiner's statement of reasons for allowance of the claims 1-13 and 20 of the amendment dated 11/14/2008: Nothing in the prior art anticipates or suggests, "manually and automatically re-positioning and re-sizing the zoom window and the inking region relative to at least one digital document, the re-positioning and re-sizing of the zoom window and the inking region occurs at least as annotation of the at least one digital document is entered in the inking region during the annotation event as a function of an amount of annotation

information entered and displayed in the inking region, wherein size of the zoom window corresponds to size of the inking region, in a computer-implemented method that provides a zoom window to annotate digital documents with digital ink.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JIN-CHENG WANG whose telephone number is (571)272-7665. The examiner can normally be reached on 8:00 - 6:30 (Mon-Thu).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kee Tung can be reached on (571) 272-7794. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jin-Cheng Wang/  
Primary Examiner, Art Unit 2628